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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/625,300
Filing Date: July 24, 2000
Appellant(s): HICKMAN ET AL.

Paul L. Hickman
Reg. No. 28,516
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 September 2011 appealing from the
Office action mailed 18 November 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

USSN 09/648715

USSN 09488862

USSN 09488863

USSN 09488962

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 14-17, 21-32, and 36 are pending and rejected.

Claims 21-30 are withdrawn.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6434580	Takano et al.	8-2002
6671805	Brown et al.	12-2003
6493722	Daleen et al.	12-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 36 remains rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (US 6434580, filed 23 October 1998, hereafter Takano).

As per independent claim 36, Takano discloses a communications system comprising:

- a client computer coupled to the Internet (Figure 15, item 200: Here, a client computer is used to file applications with the "Patent Office")

- an applicant computer coupled to the Internet and communicating with the client computer (Figure 15, item 100: Here, the applicant, or inventor, enters information, stored at a server computer. The entered information is uploaded to the server, and is accessible by the applicant's representation for filing documents with the receiving agency)

- an intermediary server coupled to the Internet communicating with the client computer, the client computer serving as an intermediary between the applicant computer and the intermediary computer (Figure 15, item 300: Here, the data input by the application, or inventor, is uploaded to the intermediary server. The client computer,

being operated by the applicant's representation, allows the contents to be obtained from the server)

a recipient server coupled to the Internet and communicating with the intermediary server, the intermediary server serving as an interface between the client computer and the recipient server, whereby the recipient server communicates with the intermediary server as if the recipient server were communicating directly with the applicant computer (Figure 15, item 1000; claim 2)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Brown et al. (US 6671805, filed 17 June 1999, hereafter Brown).

As per independent claim 1, Takano discloses an automated electronic filing system comprising:

a web server coupled to the Internet (column 5, lines 45-51; Figure 15, item 300: Here, a server is connected to the Internet)

a receiving agency server separate from the web server and coupled to the Internet, such that it is capable of communication with the web server (Figure 15, items 300 and 1000: Here, the web server and the Patent Office, or receiving agency server, are coupled to the Internet)

a client machine separate from the web server and the receiving agency server and coupled to the Internet for communication with the web server, the client machine providing information to the web server forming at least a part of an electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving agency computer for the client machine, the electronic document filed for further processing by a receiving agency associated with the receiving agency server in accordance with a procedure for which the receiving agency is in some manner responsible (Figure 15; column 6, lines 5-15 and 44-59)

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the form includes at least one of a blank form and a partially filled-in form based upon

information stored on the web server, wherein the form can be at least partially automatically filled-in in response to the selection (Figures 3 and 15; column 9, lines 11-35: Here, a template is downloaded. The template includes form fields, which are partially filled by reading a specification file)

Takano fails to specifically disclose:

wherein communication between computers is authenticated and is at least partially encrypted

wherein the server provides the client with a form which can be verified by the server using heuristics

wherein the server automatically updates docketing information

wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client

Brown discloses:

authentication and encryption of communications between computers across a network (column 8, lines 23-34; column 9, lines 21-31)

wherein the server provides the client with a form which can be verified by the server using heuristics (column 8, lines 23-34; column 9, lines 21-31)

wherein the server automatically updates docketing information (column 21, lines 20-27)

wherein the web server transacts a financial transaction with the receiving agency server on behalf of the client (Figure 8g; column 24, lines 11-43)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user ensure the integrity of legal documents.

As per dependent claim 14, Takano and Brown disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Takano discloses an applicant machine coupled to the Internet (Figure 15).

As per dependent claim 15, Takano and Brown disclose the limitations similar to those in claim 14, and the same rejection is incorporated herein. Takano further discloses wherein the applicant machine communicates with the web server the Internet (Figure 15).

As per dependent claim 16, Takano and Brown disclose the limitations similar to those in claim 15, and the same rejection is incorporated herein. Brown further discloses wherein communications between computers across a network are at least partially encrypted (column 9, lines 21-31). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user to security transmit information across a network.

As per dependent claim 17, Takano and Brown disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Brown further discloses wherein the communication between machines are subject to authentication (column 8, lines 23-34). It would have been obvious to one of ordinary skill in the art at

the time of the applicant's invention to have combined Brown with Takano, since it would have allowed a user to verify the sender of content.

Claims 31-32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Takano and further in view of Daleen et al. (US 6493722, filed 13 April 1999, hereafter Daleen).

As per independent claim 31, Takano discloses an automated electronic filing system for use in electronic prosecution of trademark applications comprising:

- a web server coupled to a wide area network (column 5, lines 45-51; Figure 15, item 300: Here, a server is connected to the Internet)

- a receiving agency server separate from the web server and coupled to the wide area network such that it is capable of communicating with the web server, the receiving agency server associated with a governmental agency responsible for the administration of trademark registration (Figure 15, items 300 and 1000: Here, the web server and the Patent Office, or receiving agency server, are coupled to the Internet)

- a client machine separate from the web server and the receiving agency server and coupled to the wide area network for communication with the web server, such that the web server serves as an interface to the receiving agency server, the client machine providing information to the web server forming at least a part of an electronic document related to prosecution of a trademark application or maintenance of a trademark registration, the electronic document to be filed with the receiving agency server by the web server in a manner that the web server serves as an interface to the receiving

agency computer, the electronic document filed for further processing by the governmental agency in accordance with pre-established rules (Figure 15; column 6, lines 5-15 and 44-59)

wherein the web server automatically produces at least a portion of the electronic document in response to a selection originating from the client machine, wherein the web server provides the client machine with a form, wherein the form can be at least partially automatically filled-in in response to the selection (Figures 3 and 15; column 9, lines 11-35: Here, a template is downloaded. The template includes form fields, which are partially filled by reading a specification file)

wherein the web server serves as an interface between the client machine and the receiving agency server (claim 2)

Takano fails to specifically disclose wherein the server makes a payment on behalf of a client at a receiving agency. Daleen discloses wherein the server makes a payment on behalf of a client at a receiving agency (abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Takano, since it would have allowed a client to have his/her fees paid to a receiving agency.

As per independent claim 32, Takano discloses an automated electronic filing system comprising:

a web server capable of communicating over the Internet (column 5, lines 45-51; Figure 15, item 300)

a receiving agency server separate from the web server and capable of communicating over the Internet, the receiving agency server associated with a governmental agency (Figure 15, items 300 and 1000)

a client machine separate from the web server and the receiving agency server and capable of communicating over the Internet, such that the web server serves as an interface to the web server format at least a part of an electronic document, the electronic document to be filed with the receiving agency server by the web server for further processing by the governmental agency in accordance with pre-established rules, wherein the web server serves as an interface between the client machine and the receiving agency server, whereby the receiving agency server communicates with the web server as if the receiving agency server were communicating directly with the client machine (Figure 15; column 5, lines 5-15 and 44-59)

Takano fails to specifically disclose wherein the server makes a payment on behalf of a client at a receiving agency. Daleen discloses wherein the server makes a payment on behalf of a client at a receiving agency (abstract). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Daleen with Takano, since it would have allowed a client to have his/her fees paid to a receiving agency.

(10) Response to Argument

The applicant's initial argument is based upon the belief that Takano fails to teach the limitations of independent claim 36 (page 10).

In order to support this position, the appellant states that claim 36 is "clearly describing a system of four computers (page 11)." However, this argument is not a true assessment of the claim. The applicant's specification states that the claimed web server (Figure 1, item 14) and the receiving agency server (Figure 1, item 20) can be implemented on the same machine (Specification: page 7, lines 22-26). The applicant equates the web server with the intermediary server (page 11). Additionally, the appellant's specification states that the applicant computer (Figure 1, item 18) and the client machine (Figure 1, item 16) may be implemented on the same machine (Specification: page 8, lines 16-18). Therefore, the broadest reasonable interpretation of the claim, in accordance with the appellant's specification, does not require four computers. The appellant's specification includes embodiments wherein the intermediate server, the receiving agency server, the applicant computer, and the client machine are implemented in as few as two computers. For this reason, this argument is not persuasive.

The appellant further argues that Takano fails to disclose wherein the system of computers is chained through the internet in the configuration of applicant computer – client computer – intermediary computer – recipient computer (pages 11-12). Instead, the appellant argues that Takano discloses wherein the client is connected directly to a recipient server (page 12). In the broadest reasonable interpretation of the appellant's specification, if the applicant computer and client computer are implemented as a single machine, and the intermediary computer and the recipient computer are implemented as a single server, such a configuration satisfies the applicant's claimed limitations.

Additionally, Takano discloses a client computer of an inventor for preparing text data for a specification of a patent application (Figure 15, item 100; column 6, lines 44-59). This client computer constitutes the appellant's claimed "applicant computer." Further, Takano discloses a client computer (Figure 15, item 200; column 8, lines 7-24), coupled to the client computer via a communication network (column 5, lines 45-51). A patent-application-filing person is able to revise the draft data entered by the inventor at the "applicant computer." Next, Takano discloses an intermediary server coupled to the internet communicating with the client computer (Figure 15, item 300; column 6, lines 27-31). In this instance, the intermediary server receives data from the client computer (column 6, lines 20-26). By editing the content from the applicant computer and uploading the edited content to the intermediary server, the client computer acts as an intermediary between the applicant computer (Figure 15, item 100) and the intermediary server computer (Figure 15, item 300). Finally, Takano discloses a recipient server coupled to the internet and communicating with the intermediary server (Figure 15, item 1000; claim 2). In this instance, the patent application is sent from a storage containing revised draft data, such as the intermediary server (Figure 15, item 300) to the United States Patent and Trademark Office (Figure 15, item 1000) via a communication network. For this reason, this argument is not persuasive.

The appellant initial argument with respect to claims 1 and 14-17 is substantially similar to those presented with respect to claim 36 (page 14). The appellant further argues that the web server of claim 1 requires that the server provide authentication and encryption in its communications with other machines (page 14). The appellant

additionally argues that the web server can fill in a form based upon stored information, provide docketing functionality, and transact a financial transaction with the receiving agency server (page 14). The examiner acknowledges that Takano fails to disclose authentication and encryption of communications between computers across a network, providing a client with a form which can be verified by the using heuristics, updating docketing information, and transacting a financial transaction on behalf of a client (see Final Office Action dated 18 November 2010: pages 5-6). However, Brown discloses authentication and encryption of communications between computers across a network (column 8, lines 23-34; column 9, lines 21-31), providing a client with a form which can be verified by the using heuristics (column 8, lines 23-34; column 9, lines 21-31), updating docketing information (column 21, lines 20-27), and transacting a financial transaction on behalf of a client (Figure 8g; column 24, lines 11-43) (see Final Office Action dated 18 November 2010: page 6). The applicant argues that although Brown discloses performing these functions, Brown does not teach these functions implemented within a server (page 15). However, the examiner is not relying upon Brown disclosing these limitations within a server. The examiner is merely relying upon Brown's teaching of performing these functions. One of ordinary skill in the art at the time of the applicant's invention would have recognized that the functionality provided by Brown could be implemented in various other types of computers, including servers. Such a combination would have provided a user with a central computer (server) ensuring the integrity of legal documents.

The appellant's initial argument with respect to claims 31-32 is based upon the arguments presented with respect to claim 36 (page 16). These arguments are similarly not persuasive.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided by the appellant within the "Related Proceedings Appendix" beginning on page 22 of the Appeal Brief filed 28 September 2011.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kyle R Stork/

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